

Application No. 09/779,558

Art Unit 1713

Substance of Interview and Supplemental Reply

REMARKS

A "Notice of Non-Compliant Amendment" was mailed to Applicants on March 3, 2005, stating that the previously submitted Supplemental Reply of January 24, 2005, contained claims 21-24 that had improper status identifiers. The present Reply corrects those claim status identifiers (please also refer to claims 9, 10, 14, 15 and 16 herein). Otherwise, the contents of this Reply are the same as that of the previous Reply of January 24, 2005. Entry of this Supplemental Reply as being compliant is respectfully requested.

Interview

Applicants thank the Examiner for his time, helpfulness and courtesies extended to Applicants' representative during the Interview of January 12, 2005. Applicants believe that the Interview has advanced prosecution of the present application.

Applicants respectfully request the Examiner to reconsider the present application in view of the foregoing amendments to the claims.

Status of Claims

In the present reply, claim 26 has been added. Claims 9, 10, 14-16 and 21-24 stand withdrawn. Thus, in the present application, claims 1-26 are pending.

No new matter has been added by way of new claim 26, since this claim has support in the original claims and in the Examples of the present specification (i.e., see Example 1, page 34, lines 20+; Examples 2-3 at page 35, lines 14 and 22+; etc.). Also, see paragraph 11 of the Office Action.

Based upon the above considerations, entry of the present amendment is respectfully requested. Also, in view of the following remarks and those presented in the previous Reply of January 10, 2005, Applicants respectfully request the Examiner to withdraw all rejections and allow the currently pending claims.

Substance of the Interview

In compliance with M.P.E.P. § 713.04, Applicants provide the following remarks.

The Interview Summary form amply summarizes the discussions at the Interview. Various ways of addressing the prior art rejections were discussed, and particular aspects of the invention were discussed as not being described by the prior art.

Specifically, Applicants referred the Examiner to the revised Rule 132 Declaration and to the Table that were filed with the Reply of January 10, 2005. Applicants submitted that the Table shows why the various rejections under 35 U.S.C. § 102 and § 103(a) have been overcome, since, e.g., each of the cited references fails to disclose

the claimed evaporation loss feature. Applicants also stated that a *prima facie* case of obviousness has not been established due to the claimed feature not being within the disclosure (e.g., inherently) of the cited references. Further, Applicants asserted that the closest prior art example was tested in the Rule 132 Declaration, which rebuts and overcomes the § 103(a) rejections.

During the Interview, the Examiner indicated that the references may disclose all claimed features, though such a claimed feature (e.g., the evaporation loss of component (c)), is not literally disclosed. Further, the Examiner stated that the prior art rejections are not separate rejections under 35 U.S.C. § 102 and under 35 U.S.C. § 103(a) in view of the individual reference. Instead, the cited rejections are under § 102/103 in view of an individual reference. In this regard, the Examiner referred Applicants (via the Interview Summary) to M.P.E.P. § 2112-2112.02.

Issues Under 35 U.S.C. §§ 102(b) & 103(a)

Claims 1-8, 11 and 17-20 stand rejected by the Examiner under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) over U.S. Patent No. 4,220,579 to Rinehart ("Rinehart '579"), U.S. Patent No. 4,239,862 to Matthews ("Matthews '862"), or U.S. Patent No. 4,311,628 to Abdou-Sabet et al. ("Abdou-Sabet '628") (see paragraph 4 of the Office Action).

Also, claims 1-8, 11-13 and 17-20 stand rejected by the Examiner under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) over U.S. Patent No. 4,728,692 to Sezaki et al. ("Sezaki '692") or U.S. Patent No. 4,818,785 to Ottawa et al. ("Ottawa '785") (as stated in paragraph 5 of the Office Action).

Applicants respectfully submit that these rejections were fully addressed in the previous Reply of January 10, 2005. However, the following supplemental remarks are provided below.

§102/§103 Rejections

As mentioned, the Examiner stated that the prior art rejections in the Office Action are not separate rejections under 35 U.S.C. § 102 or under 35 U.S.C. § 103(a), but instead are single rejections under a combined §102/§103 in view of an individual reference. The Examiner also referred Applicants to M.P.E.P. § 2112-2112.02.

Applicants have reviewed M.P.E.P. § 2112-2112.02 and believe that the Examiner is referring to M.P.E.P. § 2112(III) in describing the instant rejections. However, Applicants note that the rejections as stated in the Office Action are still separate rejections and are stated in the alternative -- one rejection under § 102 in view of a reference and another under § 103(a) in view of the same reference. This part of the M.P.E.P. also describes "inherency" with respect to each provision of 35 U.S.C., and not as a combined rejection like "102/103." Thus,

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Applicants respectfully submit that the previous Reply of January 10, 2005, sufficiently addresses the outstanding rejections as stated in the Office Action of September 9, 2004.

If Applicants have misinterpreted the Examiner's position, Applicants respectfully request clarification.

Each of the cited references does not disclose all claimed features

During the Interview, the Examiner indicated that some or all of the cited references disclose some type of softening agent as possibly corresponding to Applicants' claimed component (c) of the paraffinic mineral oil softening agent. Applicants responded that the references do not disclose, at the very least, the claimed evaporation loss, and thus do not disclose the claimed invention. Still, the Examiner stated that such features like the claimed evaporation loss may or may not be within the disclosure of the cited reference.

In response, Applicants respectfully submit that the Office Action does not specifically explain why any one of the cited references inherently possesses all claimed features. In paragraph 10 of the outstanding Office Action, the Examiner states, "the prior art may not expressly teach the disclosed properties in the claimed composition (i.e., the evaporation loss or kinetic viscosity of the paraffinic oil), it is ... and the USPTO does not have at its disposal the tools or facilities deemed necessary to make physical determinations of the

sort." The current Office Action also explains the rejections as being maintained for reasons as stated in previous Office Actions, wherein the previous Office Actions (e.g., the Office Action of May 20, 2003) refer to the first Office Action (dated October 11, 2002). The first Office Action of October 11, 2002, in a fashion similar to the current Office Action, states that Rinehart '579, Matthews '862 and Abdou-Sabet '628 "do not expressly teach the disclosed properties in the claimed composition (i.e., the evaporation loss or kinetic viscosity of the paraffinic oil)... and the USPTO does not have at its disposal the tools or facilities deemed necessary to make physical determinations of the sort" (see page 9, second paragraph of the first Office Action). However, Applicants respectfully submit that the reasons stated in the Office Actions amount to mere possibilities or probabilities that, e.g., the claimed evaporation loss is within the disclosure of any of the cited references.

In this regard, Applicants respectfully refer the Examiner to M.P.E.P. § 2112(IV), wherein a certain result or characteristic, like evaporation loss, that may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic (citing *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) and *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981)). Further, the court in *In re Robinson* stated:

To established inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily

present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (as also cited in M.P.E.P. § 2122(IV), at page 2100-54, revised May 2004). As stated in the outstanding Office Action, inherency has not been established with respect to the features that each of the cited references fails to disclose (i.e., the claimed evaporation loss). Further, it has not been established in the Office Action that a person of ordinary skill in this elastomer art would recognize that the compositions of the various references would have all of the instantly claimed features, based on the disclosure of each individual reference. Thus, Applicants respectfully submit that all rejections have been overcome (whether under § 102(b) or § 103(a)). Withdrawal thereof is respectfully requested.

Further, any assertion that the cited references disclose all instantly claimed features is clearly rebutted by Applicants' previous Reply. In particular, in the Reply of January 10, 2005, Applicants submitted a Table (see page 17 of the Reply) and other arguments that show how each references fails to disclose all instantly claimed features. If the burden has shifted to Applicants, Applicants respectfully submit that their burden has been met with the January 10 Reply. Still, if it is the Examiner's position that all claimed features

of the present invention are still disclosed or present in any one of the cited references, Applicants respectfully request such clarification.

Added distinctions over the cited references

As can be seen from the previously submitted Rule 132 Declaration (attached to the Reply of January 10, 2005), the claimed invention is patentable over each of the cited references, since the references use commercially available paraffinic oils having an evaporation loss of more than 0.4%. In the Rule 132 Declaration, an olefinic thermoplastic elastomer composition was produced [molded] as in an Example of the present specification, except a mineral oil softening agent Tufflo 6056 was used, wherein Tufflo 6056 is used in the Rinehart '579 reference. The results are shown in Table 1 on page 2 of the Declaration.

Applicants also submit that Rinehart '579 represents the closest prior art example. With regard to examples from any of the other cited references of Matthews '862, Abdou-Sabet '628, Sezaki '692 and Ottawa '785, each of these references does not define a trade name of paraffinic oil. Therefore, Applicants cannot submit any data regarding the paraffinic oils described in Matthews '862, Abdou-Sabet '628, Sezaki '692 or Ottawa '785. Further, the paraffinic oils as generally used in the said references do not meet the claimed requirement of "an evaporation loss of 0.4% by weight or less." The lack of disclosure

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itself overcomes all rejections in view of each of Matthews '862, Abdou-Sabet '628, Sezaki '692 and Ottawa '785.

Thus, Applicants respectfully request consideration of the existing data as shown in the Rule 132 Declaration. As can be seen from the Rule 132 Declaration, Applicants respectfully submit that the claimed invention provides an olefinic thermoplastic elastomer composition having unexpectedly superior antifogging properties (e.g., low hazing property) by using paraffinic oil having an evaporation loss of 0.4% or less. Thus, Applicants respectfully submit that all rejections have been overcome. Reconsideration and withdrawal of all rejections are respectfully requested.

Conclusion

Applicants respectfully request that a timely Notice of Allowance issue for the present case.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Eugene T. Perez (Reg. No. 48,501) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

A full and complete response has been made to all issues as cited in the Office Action with Applicants' previous Reply filed on January

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10, 2005. Thus, it is believed that no payments for further extensions of time are needed.

Still, if necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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